

REMARKS

Status of the Claims

Claims 1-8 are currently pending in the application and subject to a Restriction Requirement. (See, Office Communication of August 31, 2007, at page 2, hereinafter, "Office Communication"). Applicants traverse the Restriction Requirement as set forth herein. Reconsideration is respectfully requested.

Restriction Requirement

Claims 1-8 are subject to a Restriction Requirement under 35 U.S.C. §§ 121 and 372 for reciting inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1. (See, Office Communication, at page 2). Applicants traverse as hereinafter set forth.

The Examiner has required election in the present application between:

Group I, claims 1-3, drawn to a microorganism belonging to *Rhodococcus*;

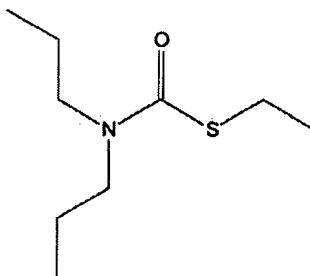
Group II, claims 4-6, drawn to a method of degrading a urethane compound using *Rhodococcus*; and

Group III, claims 7-8, drawn to a method of degrading urethane using *Rhodococcus* and another microorganism.

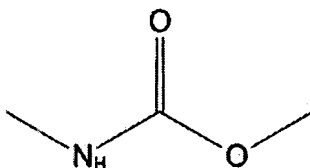
For the purpose of examination of the present application, Applicants elect, with traverse, Group I, Claims 1-3.

Applicants traverse the Restriction because the cited reference does not disclose the special technical feature of the presently claimed invention. The Examiner states that the inventions listed in Groups I-III do not relate to a single general inventive concept under PCT Rule 13.1 because there is no common inventive concept shared among the Groups. That is, the Examiner believes that Nagy et al., *J. Bacteriology*, 177:676-687, 1995 (hereinafter, "Nagy et al.") discloses "degrading urethane bonds" and that such activity in bacteria is "known in the art."

However, the Examiner misunderstands the disclosure of Nagy et al. In fact, Nagy et al. do not disclose strains capable of "degrading urethane bonds." Nagy et al. disclose, at most, strains capable of breaking *S*-ethyl dipropylcarbothioate (EPTC) bonds. EPTC bonds are not urethane bonds and are chemically distinct from urethane bonds. That is, EPTC bonds have the following structure:



wherein the structure surrounding the carbonyl is a thiocarbamate. In contrast, *urethane* bonds have the following core structure, where the sulfur atom is replaced by an oxygen atom (the following is merely one example of a type of urethane bond, *next page*):



Therefore, contrary to the Examiner's statements, Nagy et al. in fact do not disclose or suggest the presently claimed invention because the disclosure of Nagy et al. is directed to degradation of a completely different type of chemical compound.

Product v. Process of Use Statement

The Examiner is additionally reminded that because the present Restriction is between a product (claims 1-3) and its process of use (claims 4-8), where Applicants elect claims directed to the product, and a product is subsequently found allowable, withdrawn process (method) claims that depend from or otherwise include all the limitations of the allowable product claims will be rejoined in accordance with the provisions of M.P.E.P. § 821.04. Such process claims that depend from or otherwise include all the limitations of the patentable product are entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Furthermore, in the event of rejoinder, Applicants understand that the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims must be fully examined for patentability according to the provisions of 37 C.F.R. § 1.104.

Thus, reconsideration and withdrawal of the Restriction Requirement between claims 1-8 are respectfully requested.


CONCLUSION

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Thomas J. Siepmann, Ph.D., Registration No 57374 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to our Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under § 1.17; particularly, extension of time fees.

Dated: OCT - 1 2007

Respectfully submitted,

By  #43525
Marc S. Weiner
Registration No.: 32,181
BIRCH, STEWART, KOLASCH & BIRCH, LLP
8110 Gatehouse Road
Suite 100 East
P.O. Box 747
Falls Church, Virginia 22040-0747
(703) 205-8000
Attorney for Applicants